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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/021,583	10/29/2001	Easton F. Bell	F-352	3446
919	7590	04/04/2008	EXAMINER	
PITNEY BOWES INC. 35 WATERVIEW DRIVE P.O. BOX 3000 MSC 26-22 SHELTON, CT 06484-8000			VIG, NARESH	
			ART UNIT	PAPER NUMBER
			3629	
			MAIL DATE	DELIVERY MODE
			04/04/2008	PAPER

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1 UNITED STATES PATENT AND TRADEMARK OFFICE

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4 BEFORE THE BOARD OF PATENT APPEALS
5 AND INTERFERENCES
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8 *Ex parte* EASTON F. BELL, JEAN-HIRAM COFFY,
9 KENNETH G. MILLER, JAMES R. NORRIS, JR., and
10 CHERYL PICOULT TRISKA

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13 Appeal 2007-4034
14 Application 10/021,583
15 Technology Center 3600
16

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18 Decided: January 16, 2008
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21 *Before* WILLIAM F. PATE, III, ANTON W. FETTING, and DAVID B.
22 WALKER, *Administrative Patent Judges*.

23
24 PATE, III, *Administrative Patent Judge*.

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26
27 DECISION ON APPEAL
28

1 STATEMENT OF CASE

2 The Appellants appeal under 35 U.S.C. § 134 (2002) from a final
3rejection of claims 1-10 and 31-37. Claims 11-30 were canceled prior to the
4present appeal. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

5 The Appellants claim a mailing system that includes a plurality of
6devices coupled to a wireless communication network with a gateway server
7that allows communication between the devices. The communication
8network also allows service of the devices by a remote device using proxies
9created by the gateway server. The use of a wireless network is described as
10advantageously allowing the plurality of devices to be arranged in a manner
11to optimize operational efficiency of mailrooms.

12 Independent claims 1 and 31 read as follows:

- 13 1. A mailing system comprising:
14 a plurality of devices associated with mail preparation,
15 each of said plurality of devices adapted to communicate with
16 other of said plurality of devices via a wireless communication;
17 a gateway server adapted to communicate with each of
18 said plurality of devices via a wireless communication, said
19 gateway server being coupled to a communication network,
20 said gateway server and said plurality of devices forming a
21 local network, said gateway server acting as a master of said
22 local network, each of said plurality of devices communicating
23 with another of said plurality of devices via a wireless
24 communication through said gateway server; and
25 a remote device coupled to said communication network,
26 said remote device communicating with said gateway server via
27 said communication network, said gateway server creating a
28 proxy for each of said plurality of devices in said local network,

1 wherein a service of at least one of said plurality of
2 devices can be invoked by said remote device utilizing said
3 created proxy for said at least one of said plurality of devices.
4

5 31. A method for invoking a service of a mailing device by a
6 remote device, said mailing device belonging to a wireless
7 mailing system, said method comprising the steps of:
8 registering said mailing device with a gateway server,
9 said registration being done via a wireless communication-
10 between said mailing device and said gateway server;
11 creating a proxy for said registered mailing device and
12 storing said proxy in said gateway server;
13 establishing a communication between said remote
14 device and said gateway server via a network;
15 selecting a service associated with registered mailing
16 device via said communication between said remote device and
17 said gateway server; and
18 invoking said selected service via said proxy by said
19 remote device.
20

21 The prior art relied upon by the Examiner in rejecting the claims is:

22Le Carpentier	4,752,950	Jun. 21, 1988
23Lee	5,657,689	Aug. 19, 1997
24Sinclair, "Wireless Networking Review," <u>AutomatedBuildings.com</u> , pp. 1-2,		
25May 1, 2001.		

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1 The Examiner rejected claim 37 under 35 U.S.C. § 112 as indefinite
2for failing to particular point out and distinctly claim the invention.¹

3 The Examiner rejected claims 1-10 and 31-37 under 35 U.S.C. §
4103(a) as obvious in view of Le Carpentier, Lee, and Sinclair.

5 We AFFIRM.

6

7

ISSUES

8 The following issues have been raised in the present appeal.

9 1. Whether the Appellants have shown that the Examiner erred in
10rejecting claim 37 as indefinite.

11 2. Whether the Appellants have shown that the Examiner erred in
12rejecting claims 1-10 and 31-37 as obvious in view of the cited prior art.

13

14

FINDINGS OF FACT

15 The record supports the following findings of fact (FF) by a
16preponderance of the evidence.

17 1. Prior art mailroom devices include postage meters, weight
18scales, mail processing machines, and computers (Spec. 1, ll. 8-11).

19 2. Prior art mailroom devices are “typically coupled to each other
20to form a network and operate in conjunction with each other by passing
21information and data to each other via the network” (Spec. 1, ll. 11-13).

15¹ Rejection of claims 1 and 31 under 35 U.S.C. § 112 as set forth in the Final
16Office Action was withdrawn in the Examiner’s Answer (Ans. 7, ll. 2-4).
17Thus, the Appellants’ arguments regarding rejection of claims 1 and 31
18under 35 U.S.C. § 112 are moot.

1 3. Le Carpentier discloses a remote control system for franking
2machines including a plurality of devices 1C-1E associated with mail
3preparation and a gateway server 4Y adapted to communicate with each of
4the plurality of devices via a local network 11Y, the gateway server and the
5plurality of devices forming a local network 11Y (Fig. 1; Col. 2, ll. 24-44
6and 54-66; Col. 6, ll. 1-9; Col. 8, ll. 24-30).

7 4. Le Carpentier also discloses the gateway server 4Y being
8coupled to a communication network 3, a remote device 2 coupled to the
9communication network 3 and the remote device communicating with the
10gateway server 4Y via the communication network 3 (Col. 2, ll. 24-44).

11 5. Le Carpentier further discloses that the remote device 3
12communicates with each of the plurality of devices 1C-1E to service at least
13one of said plurality of devices (Col. 1, l. 59-Col. 2, l. 2; Col. 2, ll. 45-53).

14 6. Lee discloses a franking machine system including a gateway
15server 32 adapted to communicate with each of a plurality of devices 30_n
16associated with mail preparation via a wireless communication, the gateway
17server being coupled to a communication network 34 (Col. 2, ll. 48-57 and
1865-67).

19 7. Lee also discloses a remote device 31 that can be used to
20service the plurality of devices and teaches that predetermined signals
21transmitted during communication between the franking machine and the
22secure unit is different for each franking machine (Col. 3, ll. 7-11; Col. 4, ll.
2310-14 and 25-28).

1 8. Sinclair discloses a network system including a plurality of
2 devices and a gateway server adapted to communicate with each of the
3 plurality of devices via a wireless communication. The gateway server is
4 coupled to a communication network and acts as a master of the local
5 network formed by the gateway server and the plurality of devices (Sinclair
6 Fig.).

7 9. Sinclair discloses each of the plurality of devices
8 communicating with another of the devices via a wireless communication
9 through the gateway server, Sinclair noting that “[n]etworking between PC’s
10 worked right away, as well as printer and device sharing” (Sinclair 2, ll. 4-6;
11 Fig.).

12

13

PRINCIPLES OF LAW

14 35 U.S.C. § 112, second paragraph, recites that “[t]he [S]pecification
15 shall conclude with one or more claims particularly pointing out and
16 distinctly claiming the subject matter which the applicant regards as his
17 invention.” Claims are in compliance with 35 U.S.C. § 112, second
18 paragraph, if “the claims, read in light of the [S]pecification, reasonably
19 apprise those skilled in the art and are as precise as the subject matter
20 permits.” *Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367,
21 1385 (Fed. Cir. 1986).

22 In addition, “[s]ection 103 forbids issuance of a patent when ‘the
23 differences between the subject matter sought to be patented and the prior art
24 are such that the subject matter as a whole would have been obvious at the

1time the invention was made to a person having ordinary skill in the art to
2which said subject matter pertains.” *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct.
31727, 1734 (2007). In *KSR*, the Supreme Court emphasized “the need for
4caution in granting a patent based on the combination of elements found in
5the prior art,” and reaffirmed that “[t]he combination of familiar elements
6according to known methods is likely to be obvious when it does no more
7than yield predictable results.” *Id.* at 1739. The Court explained that “if a
8technique has been used to improve one device, and a person of ordinary
9skill in the art would recognize that it would improve similar devices in the
10same way, using the technique is obvious unless its actual application is
11beyond his or her skill.” *Id.* at 1740. The Court noted that the obviousness
12analysis “should be made explicit,” but that “the analysis need not seek out
13precise teachings directed to the specific subject matter of the challenged
14claim, for a court can take account of the inferences and creative steps that a
15person of ordinary skill in the art would employ.” *Id.* at 1740-41.

16

17 ANALYSIS

18 Claim 37 rejected under 35 U.S.C. § 112

19 The Examiner rejected claim 37 stating that the Appellants have not
20disclosed what constitutes “a status report” recited in the claim and
21questioned whether the status report is a printed output, or a status light on a
22device, etc. The Appellants argue that one of ordinary skill would
23understand that the recited limitation refers to “current information about
24operating conditions of a device, and could be provided in any number of

1ways” (Br. 6, ll. 1-7). The Appellants refer to the portion of the
2Specification that states “a remote device 50 can gain access to a device in
3local network 30 to obtain operating status information of a device in local
4network 30” (Spec. 6, ll. 24-26). We agree with the Appellants that one of
5ordinary skill in the electronic arts would understand the limitation “a status
6report” in view of the Specification. Therefore, the Appellants have
7established that the Examiner erred in rejecting claim 37 as indefinite.

8

9 Claims 1-10 rejected under 35 U.S.C. § 103(a)

10 The Examiner rejected independent claim 1 as unpatentable over
11Le Carpentier in view of Lee and Sinclair. Le Carpentier discloses the
12structural limitations of claim 1, but does not appear to explicitly disclose
13the plurality of devices 1C-1E communicating with each other via a wireless
14communication through the gateway server that acts as a master of the
15network, creating a proxy for each of the plurality of devices, or invoking
16service of at least one of the plurality of devices utilizing the created proxy
17(FF 3-5).

18 However, as the Examiner notes, Lee discloses wireless
19communication between a plurality of franking machines and a gateway
20server (FF 7; Ans. 4, ll. 1-6). In addition, communication between a
21plurality of devices in a mailing system is known (FF 2). Furthermore,
22remote invocation of service for the devices is disclosed in Le Carpentier
23and Lee (FF 5 and 7).

1 With respect to the gateway server acting as a master of the network,
2creating a proxy for the plurality of devices, and using the proxy in invoking
3a service recited in claim 1, we concur with the Examiner that these
4limitations are known in the art of wireless networks as evidenced by
5Sinclair. The implementation of a wireless network disclosed in Sinclair
6includes a gateway server that wirelessly interconnects a plurality of devices
7associated with mail preparation (computers), the gateway server acting as
8the master of the network in the manner referred to by the appellants so as to
9“coordinat[e] communication between each of the devices of the local
10network” (FF 1 and 8; Spec. 9, ll. 18-21).

11 In addition, as used by the Appellants, a “proxy” is a program that
12acts as “an intermediary between the wireless communications from the
13actual device and the network to which the gateway server is connected,
14thereby creating a communication channel that allows the actual device to
15send data to and receive data from the network” (Br. 5, ll. 10-13 and 22-26).
16Sinclair inherently discloses this limitation because in order for the disclosed
17wireless network to interconnect the plurality of devices and allow network
18sharing of the printer and devices, a proxy (program intermediary) must be
19created and used so as to allow identification of, and communication
20between, the computers, the printer, and the devices in the wireless network
21(FF 9).

22 Thus, it would have been obvious to one of ordinary skill in the art to
23replace the wired network as disclosed in Le Carpentier with a wireless
24network as suggested in Lee and demonstrated in Sinclair, to allow the

1 plurality of devices to communicate with each other wirelessly through the
2 gateway server in order to realize the recognized advantages of reduction in
3 wire clutter and increased portability of wirelessly networked devices.

4 The Appellants' various arguments in the Appeal Brief regarding the
5 alleged deficiencies of the prior art are noted. However, as the Examiner
6 points out, the Appellants are asserting unobviousness by arguing the prior
7 art references separately. The test for obviousness is what the combined
8 teachings of the references would suggest to those of ordinary skill in the art.
9 *In re Young*, 927 F.2d 588, 591 (Fed. Cir. 1991); *In re Keller*, 642 F.2d 413,
10 425 (CCPA 1981). Non-obviousness cannot be established by attacking
11 references individually where the rejection is based upon the teachings of a
12 combination of references. *In re Merck*, 800 F.2d 1091, 1097 (Fed. Cir.
13 1986); *In re Keller*, 642 F.2d 413, 425 (CCPA 1981).

14 We also note that the Appellants' argument that the devices of
15 Le Carpentier do not communicate with each other is unpersuasive in view
16 of the fact that communication between plurality of devices was known in
17 the art, and Sinclair discloses such communication (FF 2 and 9).
18 Furthermore, the Appellants' arguments that Lee fails to disclose a wireless
19 communication network and that Lee restricts the position of the mailing
20 machine to a predetermined location is not persuasive (Br. 7, 1. 27-Br. 8, 15;
21 FF 6 and 7). The predetermined location referred to in Lee corresponds to
22 the "user's premises" at which the secure unit is located and does not refer to
23 specific placement of the franking machines within the user's premises (Col.

12, ll. 52-67). Moreover, the Appellants' arguments regarding creation and
2use of a proxy are not persuasive for the reasons noted *supra*.

3 In view of the above, the mailing system recited in claim 1 is merely a
4“combination of familiar elements according to known methods” in that it
5merely combines a familiar networked mailing system with a wireless
6network. *KSR*, 127 S.Ct. at 1739. Thus, the claimed invention is likely to be
7obvious since “it does no more than yield predictable results.” *Id.* Therefore,
8the Appellants have failed to establish that the Examiner erred in rejecting
9independent claim 1 as unpatentable in view of *Le Carpentier*, *Lee*, and
10*Sinclair*.

11 Dependent claims 2-10 were not argued separately on appeal, and
12thus, stand or fall with their corresponding independent claim. See *In re*
13*Dance*, 160 F.3d 1339, 1340 n.2 (Fed. Cir. 1998). Since we have found that
14Appellants have failed to show that the Examiner erred in rejecting
15independent claim 1, the Appellants have also failed to show that the
16Examiner erred in rejecting dependent claims 2-10.

17

18 Claims 31-37 rejected under 35 U.S.C. § 103(a)

19 Independent claim 31 recites a method for invoking a service of a
20mailing device by a remote device. The Appellants briefly argue that the
21prior art references relied upon by the Examiner fail to specifically disclose,
22teach, or suggest, the method claimed (Br. 10, ll. 3-11). However, it is noted
23that explicit disclosure, teaching, or suggestion is not required in the
24obviousness analysis, and we agree with the Examiner that the recited steps

1of the method claimed are obvious for the reasons set forth *supra* relative to
2the Examiner’s rejection of independent claim 1. *KSR*, 127 S.Ct. at 1740-
341. In this regard, we find that registering the mailing devices with a
4gateway server is inherently disclosed in *Le Carpentier* because such
5registration would be required to allow the franking machines to be
6identified in the network for servicing purposes. Wireless implementation of
7this registering step is also inherently disclosed in *Sinclair* that establishes
8communication with each of the devices within the range of the wireless
9network (FF 8 and 9).

10 Dependent claims 32-37 were not argued separately on appeal. Thus,
11because the Appellants have failed to show that the Examiner erred in
12rejecting claim 31, the Appellants have also failed to show that the Examiner
13erred in rejecting claims 32-37. *In re Dance*, 160 F.3d at 1340 n.2.

14

15 CONCLUSIONS

16 1. The Appellants have shown that the Examiner erred in rejecting
17claim 37 as indefinite.

18 2. The Appellants have not shown that the Examiner erred in
19rejecting claims 1-10 and 31-37 as obvious in view of the cited prior art.

20

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61Application 10/021,583
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1 ORDER

2 1. The Examiner's rejection of claim 37 under 35 U.S.C. § 112 is
3REVERSED.

4 2. The Examiner's rejection of claims 1-10 and 31-37 under 35
5U.S.C. § 103(a) is AFFIRMED.

6 No time period for taking any subsequent action in connection with
7this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. §
81.136(a)(1)(iv) (2007).

9

10 AFFIRMED

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